

RECEIVED
CENTRAL FAX CENTER

AUG 15 2005

DILLON & YUDELL LLP
ATTORNEYS AT LAW

USPTO FACSIMILE TRANSMITTAL SHEET

| | | | |
|---------------|---|-------------------------|-------------------------------------|
| TO: | Examiner Andrew J. Rudy | FROM: | Eustace P. Isidore, Reg. No. 56,104 |
| ORGANIZATION: | US Patent and Trademark Office | DATE: | August 15, 2005 |
| ART UNIT: | 3627 | CONFIRMATION NO.: | |
| FAX NUMBER: | 571-273-8300 | APPLICATION SERIAL NO.: | 09/535,559 |
| ENCLOSED: | Response to Non-Compliant Appeal Brief | ATTORNEY DOCKET NO.: | AUS000060US1 |

☒ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ PLEASE RECYCLE

NOTES/COMMENTS:

Dear Examiner Rudy,

Please find attached the Response to Non-Compliant Appeal Brief

Very Truly Yours,

Eustace P. Isidore

CERTIFICATE OF FACSIMILE TRANSMISSION

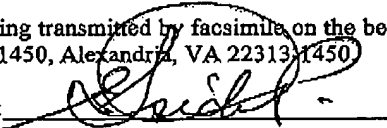
37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being transmitted by facsimile on the below date to the
U. S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450

Date:

8/15/05

By:



This fax from the law firm of Dillon & Yudell LLP contains information that is confidential or privileged, or both. This information is intended only for the use of the individual or entity named on this fax cover letter. Any disclosure, copying, distribution or use of this information by any person other than the intended recipient is prohibited. If you have received this fax in error, please notify us by telephone immediately at 512.343.6116 so that we can arrange for the retrieval of the transmitted documents at no cost to you.

8911 N. CAPITAL OF TEXAS HWY., SUITE 2110, AUSTIN, TEXAS 78759
512.343.6116 (V) • 512.343.6446 (F) • DILLONYUDELL.COM

RECEIVED
CENTRAL FAX CENTER

AUG 15 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

ATTORNEY DOCKET NO.: AUS000060US1

In re Application of:

RABINDRANATH DUTTA

Serial No.: 09/535,559

Filed: March 27, 2000

For: THIRD PARTY CONTRACT
DEPOSITORY FOR E-COMMERCE
TRANSACTIONS§
§
§
§
§
§
§
§
§

Examiner: RUDY, ANDREW J.

Art Unit: 3627

RESPONSE TO SECOND NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
UNDER 37 C.F.R. §41.37Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in response to a Notification of Non-Compliant Appeal Brief ("Notification") for the Appeal Brief filed on May 31, 2005 and pursuant to a telephonic conference with Examiner's supervisor regarding how to completely address the issues raised by the Notification. The present Brief now accounts for all claims, including those that were either cancelled or withdrawn, and the means plus function language of all independent claims have been described with greater specificity and detail in the Summary section. No fee is required to file this Compliant Appeal Brief as the fee for filing the original Appeal Brief was paid at submission. Please charge any additional required fees, to IBM Deposit Account No. 09-0447.

Certificate of Transmslssion/Mailing

I hereby certify that this correspondence is being facsimile transmitted to the USPTO at 703-872-9306 or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the date shown below.

Typed or Printed Name: Eustace IsidoreDate: August 15, 2005Signature: 

AUS000060US1

Appeal Brief

Serial No. 09/535,559

1

REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 010712, frame 0812.

RELATED APPEALS AND INTERFERENCES

An appeal filed in related patent application Serial Number 09/534,595 (Atty. Doc. AUS000060US2) filed on December 15, 2003 may directly affect or be directly affected by the Board's decision in the present appeal. There are no other appeals or interferences known to Appellant, the Appellant's legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 5, 7, 11-14 and 19-20 stand finally rejected by the Examiner, as noted in the Final Action dated October 8, 2004. Claims 1-4, 6, 8-10, and 15-18 have been canceled. Claims 21-27 have been withdrawn. The rejection of Claims 5, 7, 11-14 and 19-20 is being appealed.

STATUS OF AMENDMENTS

No amendments to the remaining claims have been made subsequent to the final rejection that leads to this Appeal.

SUMMARY OF THE CLAIMED SUBJECT MATTER

As recited by Claim 5 (and Claim 11 for the most part), Appellant's invention provides an electronic database used as a depository (illustrated as 207 in Figure 2, 505 in Figure 5A/5B, and 705 in Figure 7A) for electronic documents generated during E-commerce transactions (see Figures 4, 8A, 8B and description of e-commerce transaction throughout specification; pages 13-16). The "depository is a data processing system" (page 13, ll 1-2) that comprises executable program code which (along with hardware of the data processing system) provides the various means described within the claim elements (page 13, lines 3-21). That is, each "means for" is executable program code that provides a particular function or causes associated hardware of the depository to provide the function when executed by the processing system. Various references

AUS000060US1

Appeal Brief

Serial No. 09/535,559

2

to the program code and its/their execution by the depository is provided within the specification, for example, "registration code" (page 16, lines 28-32), transaction code (page 17, lines 2-4), and file protection subroutine (page 13, lines 6-10). Notably, Appellant's specification also provides a description of functional elements of the invention being provided by code on a computer readable medium (see page 24, line 29 – page 35, line 10). One skilled in the computer arts would appreciate that a description of a process being completed on a data processing system necessarily involves some software (program code) executing on a processor, and that the program code provides a means for completing (when executed) some processing function or causing the hardware/firmware of the data processing system to complete a function. Each "means for" recitation within the independent claims thus references the presence of software component (program code) that enables the function being described by the claim element.

The depository is a network connected device connected via the Internet to the server and client devices. Thus, the recitation of (1) "means for automatically receiving an electronic document dynamically generated from information provided during an E-commerce transaction that has completed at an E-commerce server" necessarily refers to the depository's Internet-communication hardware and associated software (program code designed to receive E-commerce documents from a server connected to depository via the Internet). Figures 2, 3, 5A, 5B, and 7A, etc all illustrate the depository connected to the Internet and/or the server and client, typical of a network connected device that both sends and receives data to and from the other network connected devices via the network (Internet). *see* also Figure 1, describing a data processing system having a network adapter 90 and page 15, lines 2-5 describing the merchant and buyer "communicating with depository." Additional description of this connectivity, including the program code associated with or providing the "means for receiving" is provided at page 13, lines 3-29 "the hard drive is controlled with program code"; page 14, lines 8-23). The remaining section of the claim element, namely "which server is independent of the electronic database, whereby said electronic document stored at said electronic database cannot be modified by either party to the E-commerce transaction" is also supported at page 13, lines 27-29; and page 14, lines 11- 18).

Additional program code is provided and executed by the processor of the depository to enable generation of a document ID. Thus, the recitation of (2) "means for generating a document identifier (ID) for said received E-commerce generated electronic document" is supported at page 16, lines 14-17 and page 17, lines 2-4, which states "[t]he depository further executes transaction code" and page 14, lines 27-29 describing "[e]ach stored document is provided with a ... identifier (ID)..." *see* also page 16, lines 14-17. The remainder of the claim element "wherein said document ID is generated at said database is illustrated by Figure 8B;

Program code is also provided and executed by the depository's processor to effect a storing of the document and ID, (and user personal information/data) within the depository's storage. Clearly an electronic depository comprises a storage that has associated operating code that directs how data/documents, etc. are stored within the storage. Thus, the recitation of (3) "means for storing said E-commerce generated electronic document with said document ID" is clearly understood as including both the storage facility of the depository and associated program code for controlling/managing the storing within the depository of e-commerce generated documents, per transaction code (page 17, lines 2-4).

Finally, program code is also provided to effect a transmittal of the document ID to both the client and server. The network communicating device of depository is again controlled by the program code executed by the depository's processor to transmit the ID to both parties. Thus, the recitation of (4) "means for transmitting said document ID to each party to said E-commerce transaction that produced said electronic document" refers to the program code (i.e., the transaction code) that effects the transmittal via the connection device to the network. *see* again, page 16, lines 14-17 and Figure 8B; transaction code (page 17, lines 2-4).

Independent Claim 11 recites similar features, namely "a depository for ensuring authenticity of electronic documents generated during E-commerce transactions" with "means for enabling automatic receipt...; means for generating a document identifier ...; and means for storing..." A similar analysis applies to these claim elements as that provided for Claim 5 elements above, namely, each means for element refers to associated program code executed by a processor of the depository to provide the various recited functions. Because of the similarity

in claim elements and associated analysis, a repeat of the above analysis is not provided; However, Appellants incorporate that analysis by reference and retains herein the prior analysis in addition to that provided above.

Thus, as stated in the previous submission, the depository comprises: (1) means for enabling automatic receipt of an electronic document that is dynamically generated in response to a completion of an E-commerce transaction in which information utilized to generate said electronic document is provided (page 13, lines 27-29; see Figures 2, 5, etc. with depository coupled to the internet and Figure 1 describing a data processing system having a network adapter 90), wherein said E-commerce transaction is completed at a server that is independent of said depository (page 13, ll 13-18; ll 32 – page 14, line 2).

Claim 11 further recites: (2) means for generating a document identifier (ID) to identify said E-commerce generated electronic document being stored at the depository (page 16, lines 14-17; see also page 17, lines 2-4, which states “[t]he depository further executes transaction code”), wherein said document ID (e.g., “reference number” of Figure 8B) is generated at said depository and is separate from a transaction ID assigned to the E-commerce transaction (see Figure 8A – 8C); and (3) means for storing said E-commerce generated electronic document in said depository along with said document ID that is utilized to reference and retrieve said electronic document from said depository (processor of Figures 1 and 305).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. The Examiner's rejection of Claim 7 under 35 U.S.C. §112 as being indefinite is to be reviewed on Appeal.
- B. The Examiner's rejection of Claims 5, 7, 11-14, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over *Quelene* (U.S. Patent No. 6,453,306) is to be reviewed on Appeal.

ARGUMENT

A. Examiner's rejection of Claim 7 under 35 U.S.C. §112, second paragraph, as being indefinite is not well founded and should be reversed.

Claim 7

At numbered paragraph 5 of the Final Office Action, Examiner rejects dependent Claim 7 and states that "Claim 7, lines 5-6 is redundant to the claim terminology of Claim 1, lines 5-7." However, Appellants have previously cancelled Claim 1. Assuming, arguendo, that Examiner has mistakenly refer to Claim 5 and Claim 1, Appellant offers that while Claim 5, lines 5-7 offers a passive description of a feature of the electronic document stored at the electronic database, Claim 7 provides an affirmative element/feature of the electronic database itself. Thus, both recitations are distinguishable from each other and not redundant to each other. Examiner's rejection of Claim 7 under 112, second paragraph, is therefore not well founded and should be reversed.

B. Examiner's rejection of Claims 5, 7, 11-14, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over *Quelene* is not well founded and should be reversed.

Claims 5, 7, 11-14, 19 and 20: Document ID Different From The Transaction ID.

The specific language of Appellant's claimed invention, namely independent Claim 5, includes at least the following features:

- (1) means for generating a document identifier (ID) ... at said database;...
- (2) means for transmitting said document ID to each party to said E-commerce transaction; and
- (3) wherein said document ID is generated at said depository and is separate from a transaction ID assigned to the E-commerce transaction

Quelene generally provides a description of a system that permits commercial transactions over a network or computers that involves propagating a proposal to multiple business relation data structures that each modify and forward the proposal based on the credit relations between businesses, whereby the consumer computer is reached with a set of proposals

(Abstract). A careful reading of *Quelene* reveals that *Quelene* is devoid of any teaching or suggestion of any one of the above highlighted features of Appellant's claims. Examiner glosses over the specific features recited in Appellant's claims and states generally that *Quelene* discloses "an electronic database where an electronic document has an associated identifier and is stored." Examiner also states that "it is common knowledge ... to provide non-modifiable read access electronic databases having a document identifier stored at a electronic database."

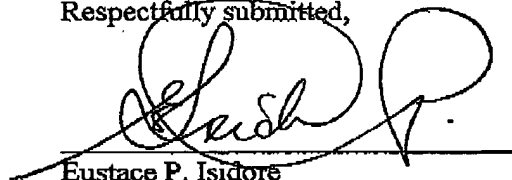
However, Examiner fails to tie in the teachings of *Quelene* with any of the functional features provided by Appellant's claimed invention. No specific citation within *Quelene* is provided, causing Appellant to conclude that no actual support could be found within *Quelene*. Having read the reference, it is clear to Appellant that *Quelene* does not teach or suggest generating the document ID at the database, or that the document ID generated is different from the transaction ID of the e-commerce transaction that created the document. Notably, during a telephonic conference with Appellant's representative, Examiner informally agreed that providing two different IDs (a database-generated document ID and a transaction ID) was not provided by either *Quelene* or "*Ebay*" (which is generally referenced without any support or tie in within the final rejection).

Thus, *Quelene* (nor the combination of *Quelene* with *Ebay*) does not render Appellant's claimed invention obvious to one skilled in the art since *Quelene* is devoid of any teaching (or suggestion) of the above listed features recited by Appellant's claims. Examiner's rejection of the above claims as unpatentable over *Quelene* is therefore not well founded and should be reversed.

CONCLUSION

Appellant has pointed out with specificity the manifest error in the Examiner's rejections, and the claim language that renders the invention patentable over the reference. Appellant, therefore, respectfully requests that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,



Eustace P. Isidore
Reg. No. 56,104
DILLON & YUDELL LLP
8911 N. Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512-343-6116

ATTORNEY FOR APPELLANT

AUS000060US1

Appeal Brief
8

Serial No. 09/535,559

APPENDIX

1-4. (canceled)

5. An electronic database used as a depository for electronic documents generated during E-commerce transactions, comprising:

means for automatically receiving an electronic document dynamically generated from information provided during an E-commerce transaction that has completed at an E-commerce server, which server is independent of the electronic database, whereby said electronic document stored at said electronic database cannot be modified by either party to the E-commerce transaction;

means for generating a document identifier (ID) for said received E-commerce generated electronic document, wherein said document ID is generated at said database;

means for storing said E-commerce generated electronic document with said document ID; and

means for transmitting said document ID to each party to said E-commerce transaction that produced said electronic document.

6. (canceled)

7. The electronic database of Claim 5, wherein said means for storing further comprises:

means for allowing a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction; and

means for preventing modifications to said E-commerce generated electronic document after said document has been stored.

8-10. (canceled)

11. A depository for ensuring authenticity of electronic documents generated during E-commerce transactions, said depository comprising:

means for enabling automatic receipt of an electronic document that is dynamically generated in response to a completion of an E-commerce transaction in which information

AUS000060US1

Appeal Brief
9

Serial No. 09/535,559

utilized to generate said electronic document is provided, wherein said E-commerce transaction is completed at a server that is independent of said depository;

means for generating a document identifier (ID) to identify said E-commerce generated electronic document being stored at the depository, wherein said document ID is generated at said depository and is separate from a transaction ID assigned to the E-commerce transaction; and

means for storing said E-commerce generated electronic document in said depository along with said document ID that is utilized to reference and retrieve said electronic document from said depository.

12. The depository of Claim 11, wherein said storing means includes:

means for limiting a write access of said electronic document to a first access; and

means for restricting subsequent access to said electronic document to read-only access, such that no changes may be made to said electronic document once it has been stored.

13. The depository of Claim 11, further including:

means for controlling a read and write access to said electronic depository, wherein said electronic document is stored in a write-once, read-many format;

means for providing said document ID to each party of the E-commerce transaction; and

means for later retrieving said electronic document for read access by a party to said E-commerce transaction utilizing said document ID.

14. The depository of Claim 13 wherein said controlling means further includes:

means for enabling a non-modification function for said electronic document, wherein a control code of said electronic depository is activated to prevent later modification to said electronic document; and

when said depository also stores other documents that are not generated by the E-commerce transactions, means for flagging each E-commerce generated electronic document stored within said electronic depository to allow only a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction, wherein write access is permitted for said other documents that are not flagged.

15-18. (canceled)

19. The electronic database of Claim 5, further comprising:

means for connecting said electronic database to a separate, independent server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said electronic database via said connecting means.

20. The depository of Claim 11, further comprising:

means for connecting said depository to a separate, independent server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said depository via said connecting means.

21-27. (withdrawn)